

SP



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,021	10/10/2003	Kenneth Turos	2067.030	3201

7590 03/10/2005

Ray R. Regan
LAW OFFICE OF RAY R. REGAN, P.A.
P.O. Box 1442
Corrales, NM 87048

EXAMINER

ADDISU, SARA

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,021

Applicant(s)

TUROS, KENNETH

Examiner

Sara Addisu

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/10/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/10/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "14" has been used to designate both cutter and arm (Figure 1 & 2 and Page 3, lines 18 & 19). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "14" and "16" have both been used to designate "the arm" (e.g. see Figures 1, 2 & 3). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

Art Unit: 3722

notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show thread 58 as described in the specification on page 5, line 3 and threaded passageway 72a,b (passageway is shown but it's not threaded) as described in the specification on page 6, line 1. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: Page 3, line 19, arm "14" should be changed to "16".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 14, it is not clear to one of ordinary skill in the art how the invention will pivot if the bore of the swivel member ("the at least one corresponding hole") is threaded.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3722

Regarding claim 10, The Specification and the Drawings do not clarify what the Applicant is considering to be "a keeper" (also see page 4, line 6).

Regarding Claim 13, it is not clear what the applicant means by "substantially dimensionally equivalent". Further review of the Specification indicates no range to support the claimed subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

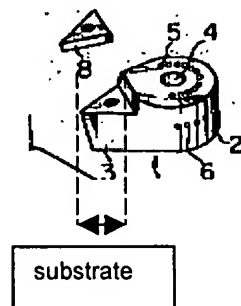
Claims 1-9, 11-13 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (U.S. Patent No. 4,057,884).

Suzuki teaches a tool having an elongated shank (arm) (11), a tool bit supporting member (swivel member) (1) with series of indexing recesses (5) spaced from each other at an angle of 15 degrees over a range of 180 degrees (i.e. capable of adjustably positioning the swivel member at an acute angle, between 0 and 35 degrees, to the longitudinal axis), a coupler for removably connecting the arm to the swivel member and locking means to position the removable tool bit (8) that is located on the leading end of swivel member (see Figure 1 and Col. 2, lines 30-32). Suzuki also teaches one end of the elongated shank (arm) (11) having spaced limbs with opposing bores (a plurality of monolithically formed bar extensions) (12 & 13) to create a recess (slot) (15) to

Art Unit: 3722

rotatably receive body portion (monolithically formed tongue) (2) formed at one end (i.e. trailing end) of the swivel member (1). [Merriam-Webster Online Dictionary defines monolithic as: cast as a single piece/ consisting of or constituting a single unit].

Furthermore, Suzuki teaches the body portion (tongue) (2) having a bore (4) {which is substantially equivalent to the opposing bores of bar extensions 12 & 13}, and a generally cylindrical shape (i.e. the curved portion constituting partially beveled) accompanied with series of indexing recesses (6) for restricting movement of the swivel member (1). Additionally, Suzuki teaches a tool (key) (27) and locking means that include tightening bolt (connector) (16) that extends between bore (4) of the swivel member (1) and the opposing bores of limbs (12 & 13) (See Figures 1 & 2). Suzuki also teaches a swivel member having a substrate to which the tool bit (8) is removably mounted (see diagram below). Figures 1, 3 and 4 show the substrate and the tool bit having variable dimensions (e.g. triangular, circular and diamond shaped).



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 4,057,884).

Suzuki discloses the claimed invention except for, the swivel member formed a slot between two extensions and the arm formed a tongue. It would have been obvious to one having ordinary skill in the art at the time of the invention was made reverse the location of the two extensions (having a bore) with the tongue (having a hole), since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167.

Applicant should further note that Specification gives no criticality to the claimed limitation (see Page 6, lines 19-25).

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 4,057,884) in view of Turos (U.S. Patent No. 6,279,919).

Suzuki teaches a tool with an arm, swivel member having a cutter as set forth in the above rejection.

Art Unit: 3722

However, Suzuki fails to teach workpiece on a rotatable shaft (brake lathe adapter system).

Turos teaches the use of a brake lathe adapter system to secure a brake rotor to a rotatable shaft of a lathe (Col. 1, lines 17-20). Turos also teaches the use of cutting tool to refinish or resurface the secured brake rotor (Col. 2, lines 22-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to adapt Suzuki's invention to the brake lathe system as taught by Turos' for the purpose of machining a workpiece (e.g. brake rotor) ('919, Col. 1, lines 22-24).

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 4,057,884) in view of Turos (U.S. Patent No. 6,279,919), and further in view of Gifford et al. (U.S. Patent No. 1,435,288).

Suzuki teaches a tool with an arm, swivel member having a cutter as set forth in the above rejection. Suzuki also teaches threads within at least one of the hollow bores of the arm (i.e. bar extension 13).

Turos teaches the use of a brake lathe adapter system to secure a brake rotor to a rotatable shaft of a lathe as set forth in the above rejection.

However, Suzuki and Turos fail to teach the arm of the tool having a hexagonal cross section.

Gifford et al. teaches a tool having a rod/handle (11) having a hexagonal shape (See Figure 1& 2 and Page 2, left col., line 28).

Art Unit: 3722

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Suzuki's invention such that the arm has a hexagonal cross-section as taught by Gifford et al. for the purpose of providing ease of grip/handling.

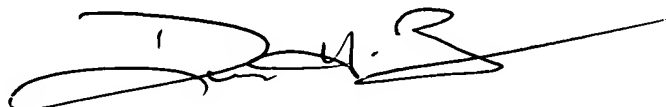
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sara Addisu
(571)272-6082



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 8700